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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,500	05/10/2005	Masayuki Ohashi	Q87811	3382
23373 7590 02/06/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER WYROZEDSKI LEE, KATARZYNA I	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 02/06/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,500

Applicant(s)

OHASHI ET AL.

Examiner

Katarzyna Wyrozebski

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-12 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-12 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

In view of applicant's response dated 2/2/2009 in the afterfinal response, the examiner is in agreement with the applicants. The finality of the office action is hereby withdrawn. Non-final office action is issued. However, the examiner considers the applicants' arguments not commensurate with majority of the claims or grounds of rejection. The arguments will be withdrawn and the rejections of record are incorporated here by reference.

Claims – applicants cancelled claims 4, 5, 13 and 14, claims 1-3, 6-12, 15-18 are pending.

Claim 1, is a claim disclosing intended use “for tire tread”, wherein patentable weight is given to the product and not to the process by which it is made.

Double Patenting Rejection – in view of properly filed terminal disclaimer this rejection is overcome.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 6-12, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over RALWINSON (US 2002/0198296) in view of IMAI (US 4,360,049).

With respect to the above disclosure RAWLINSON discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraphs [0024-0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to RALWINSON, addition of oils to such compositions, which oils are non-carcinogenic and resulting compositions, especially for tire treads have improved wet skid behavior as compared to the rubbers which do not have such oil.

The difference between the teachings of RAWLINSON and the instant invention lies in newly added limitation to the independent claims, which limitation includes rubber viscosity.

The discussion of the disclosure of the prior art of IMAI from paragraph 4 of the office action dated 3/19/08 is incorporated here by reference.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil with rubbers having viscosity molecular weight as those disclosed in IMAI and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance, wherein the oil would still extend the rubber as it is taught in RAWLINSON.

3. Claims 1-3, 6-12, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over SOHEN (US 2002/0045697) in view of IMAI (US 4,360,049).

With respect to the above disclosure SOHEN discloses rubber composition for use in tire tread. Specifically applicant's attention is drawn to paragraph [0025], which recites hydrogenated naphthenic oils having DMSO extraction of less than 3 wt %.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil. The resulting composition also appears to have improved anti-staining property.

The difference between the teachings of SOHEN and the instant invention lies in newly added limitation to the independent claims, which limitation includes rubber viscosity.

The discussion of the disclosure of the prior art of IMAI from paragraph 4 of the office action dated 3/19/08 is incorporated here by reference.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil with rubbers having viscosity molecular weight as those disclosed in IMAI and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance, wherein the oil would still extend the rubber and improve anti-staining properties. .

4. Claims 1, 2, 6-8, 10-12, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over RALWINSON (US 2002/0198296) and IMAI (US 4,360,049) in view of HASHIMOTO (EP 939,104).

The discussion of the disclosure of the prior art of RAWLINSON and IMAI from paragraph 2 of this office action is incorporated here by reference.

The discussion of the disclosure of the prior art of HASHIMOTO from paragraph 5 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of HASHIMOTO and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

According to RALWINSON, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of HASHIMOTO and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

5. Claims 1, 2, 6-8, 10-12, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over SOHEN (US 2002/0045697) and IMAI (US 4,360,049) in view of.

The discussion of the disclosure of the prior art of SOHEN and IMAI from paragraph 3 of this office action is incorporated here by reference.

The discussion of the disclosure of the prior art of HASHIMOTO from paragraph 5 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of HASHIMOTO and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of HASHIMOTO and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

6. Claims 1, 2, 6-8, 10, 11, 12, 15, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over RUSSELL (GB 2,239,870) in view of RALWINSON (US 2002/0198296) and evidence provided in IMAI (US 4,360,049).

The discussion of the disclosure of the prior art of RAWLINSON and IMAI from paragraph 2 of this office action is incorporated here by reference.

The discussion of the disclosure of the prior art of RUSSELL from paragraph 7 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of RUSSELL and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

According to RALWINSON, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of

RUSSEL and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

7. Claims 1, 2, 6-8, 10, 11, 15, 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over SOHEN (US 2002/0045697) and IMAI (US 4,360,049) in view of RUSSELL (GB 2,239,870).

The discussion of the disclosure of the prior art of SOHEN and IMAI from paragraph 3 of this office action is incorporated here by reference.

The discussion of the disclosure of the prior art of RUSSELL from paragraph 7 of the office action dated 3/19/08 is incorporated here by reference.

The difference between the teachings of RUSSELL and the instant invention lies in newly added limitation to the independent claims, which limitation includes hydrogenated naphtheic oil in the composition.

According to SOHEN, addition of oils to such compositions improves wet skid behavior as compared to the rubbers which do not have such oil.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize such oil in the composition of RUSSELL and thereby obtain the claimed invention. Such modification would provide tire tread having improved wet skid resistance.

a) Applicant's arguments are considered moot, since the examiner changed the grounds of rejections. Prior art of RAWLINS is a very good reference, where the presence of TDAE and MES in actually preferred [0029].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 8:30 AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katarzyna Wyrozebski/

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Primary Examiner, Art Unit 1796

February 4, 2009